

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed September 23, 2005. In the Office Action, the Examiner rejected claims 1, 3-12, 14-23, and 25-33 under 35 U.S.C. § 112, claims 1, 3-12, 14-43 and 25-33 under 35 U.S.C. § 102.

Applicant has amended independent claims 1, 12, and 23 to further clarify the embodiments of the invention.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 112

Claims 1, 3-12, 14-23, and 25-33 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was allegedly not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Particularly, the Examiner objected to the limitations related to “upon a user logging on to a virtual store” and the limitation “without regard to a user profile”. Particularly, the Examiner interpreted the limitation “user logging on...” as requiring a user ID and password.

Applicant has amended independent claims 1, 12, and 23 such that they no longer include the limitations objected to under 35 U.S.C. § 112, first paragraph.

Accordingly, Applicant respectfully requests that the Examiner withdraw this ground for rejection.

However, Applicant would like to note that according to the Computer Desktop Encyclopedia, Second Edition (1999) the term “logging on” generally relates to gaining access to a computer system, and only if access is restricted (i.e., in a special case), does logging on require a user ID and/or password be submitted by a user. Applicant can provide this citation to the Examiner upon request.

Claims 3-11, 14-22, and 25-33 also stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Particularly, the Examiner objects to the limitation “without regard to a user profile” due to an alleged conflict with the Examiner’s interpretation of the term “logging on”. Further, the Examiner objects to the term “without regard to a user profile” because it is allegedly a negative limitation.

Applicant has amended independent claims 1, 12, and 23 such that they no longer include these limitations.

Therefore, Applicant respectfully requests that the Examiner remove this ground for rejection.

However, Applicant would like to note that “The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation.” MPEP § 2173.05 (i). (Emphasis added). Therefore, Applicant respectfully reserves the right to utilize this limitation in further prosecution of the case.

Rejection Under 35 U.S.C. § 102

Claims 1, 3-13, 14-23, and 23-33 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,371,222 issued to Jacobi et al. (hereinafter Jacobi).

MPEP § 2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The *identical invention* must be shown in as complete detail as contained in the ... claim.” (Emphasis added). *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Applicant has amended independent claims 1, 12, and 23 such that they all basically recite: upon a user accessing a virtual store having a visual browser via a computer

network...displaying a *random assortment of graphical representations of products* to the user associated with the virtual store...creating a plurality of categories, each category identifying an attribute...associating products having at least one attribute with at least one category...allowing a user in communication with the virtual browser *to non-explicitly select a main product*...and...*upon selection of the main product, automatically displaying a plurality of related products having at least one attribute in common with the main products that are selectable for purchase by the user.*

Applicant has amended these claims to further clarify the embodiments of the invention. As set forth in Applicant's patent application on pages 11-12: "The visual browser of the present invention allows a user to navigate a virtual store hosted by an ISP, *without needing to express verbally what they are looking for (i.e. an explicit method), and instead provides non-explicit methods for virtual shopping.*...In particular, after a user picks a main product, the visual browser automatically presents similar and related products, and also possibly non-related products, to the user providing opportunities for the user to view and possibly purchase these other related and non-related products." (Emphasis added).

As set forth in Applicant's Background, on pages 2-3 of Applicant's patent application: "Currently, most e-commerce virtual shopping experiences rely on users explicitly knowing what they are looking for and describing it in verbal ways (*i.e. an explicit method*)...For example, most virtual shopping through today's e-commerce websites *requires a user to search for products by imputing verbal terms, going down through a multitude of different categories, or selecting various product attributes stored in a database to finally find a desired product.*"

The Jacobi reference utilized by the Examiner sets forth this exact same type of *explicit methodology*.

Applicant respectfully submits that nowhere does Jacobi teach or suggest: upon a user accessing a virtual store having a virtual browser via a computer network...*displaying a random assortment of graphical representations of products* to the user associated with the virtual store...allowing a user in communication with the visual browser *to non-explicitly select a main product*...and upon selection of the main product...automatically displaying a plurality of related

products having at least one attribute in common with the main product that are selectable for purchase by the user.

Applicant would like to note that the Office Action alleges that a user logging on to a virtual store having a virtual browser via a computer network and displaying a random assortment of products to the user is taught by Jacobi (citing column 5, lines 19-22 and 32-35 of Jacobi).

Applicant respectfully disagrees.

Applicant would like to point out that these citations (column 5, lines 19-22 and 32-35) from Jacobi by the Office Action only refer to an Amazon.com web-site that includes functionality for allowing users to search, browse, and make purchases from an on-line catalog...and that allows a user to create multiple shopping carts within a single account. (Emphasis added).

Applicant respectfully submits that these citations do teach or suggest *displaying a random assortment of products to a user*.

Moreover, these methods set forth in Jacobi are clearly explicit methods, and in fact teach away, from Applicant's amended independent claims related to displaying *a random assortment of graphical representations of products* to the user associated with the virtual store...and...allowing a user in communication with the visual browser *to non-explicitly select a main product*.

Therefore, Applicant respectfully submits that Jacobi does not teach or suggest the limitations of Applicant's independent claims, nor does it teach the identical invention.

The other citations by the Office Action from Jacobi for allegedly teaching Applicant's claim limitations related to: upon selection of a main product by a user, automatically displaying a plurality of related products having at least one attribute in common with the main product, etc., instead, generally relate to recommendation services to recommend products that are predicted to

be of interest to the user based upon the user's known interests, likes, dislikes, etc. (i.e. based upon some sort of user profile).

As previously discussed, Applicants claim limitations are based upon not utilizing a user profile but instead displaying *random assortments of graphical representations of products...* allowing a user in communication with the visual browser *to non-explicitly select a main product...* and then upon a selection of a main product, automatically displaying a plurality of related products.

Applicant would like to reiterate that Jacobi teaches a service that recommends products or other items to a user based on a set of items known to be of interest to the user, such as items currently in the user's electronic shopping cart (e.g. See Abstract, lines 1-5, emphasis added). In fact, Jacobi's function and purpose is aptly described in its title: "Use of Electronic Shopping Cart to Generate Personal Recommendations."

In describing the problem with past recommendation systems, Jacobi states that, "existing systems do not provide a mechanism for recognizing that the user may be searching for a particular type of category or item." (Column 2, lines 26-29). To solve this problem, Jacobi teaches that "the service identifies items that are currently in a user's shopping cart, and uses these items to generate a list of additional items that are predicted to be of interest to the user..." (Abstract).

Applicant respectfully submits that Applicant's amended independent claims 1, 12, and 23 are not taught or suggested by Jacobi, because Jacobi is related to providing an improved recommendation system based upon products that are known to be of interest to the user.

Therefore, Applicant respectfully submits that Jacobi does not anticipate Applicant's amended claim limitations 1, 12, and 23. Therefore, Applicant respectfully requests that independent claims 1, 12, and 23 be allowed and passed to issuance, as well as the claims that depend therefrom.

Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1, 3-12, 14-23, and 25-33 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 2/23/2006

By


Eric T. King

Reg. No. 44,188

Tel.: (714) 557-3800 (Pacific Coast)

Attachments

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

I hereby certify that this correspondence is, on the date shown below, being:

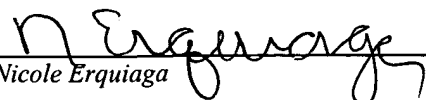
MAILING

FACSIMILE

☒ deposited with the United States Postal Service
as first class mail in an envelope addressed to:
Commissioner for Patents, PO Box 1450,
Alexandria, VA 22313-1450.

☐ transmitted by facsimile to the Patent and
Trademark Office.

Date: 2/23/2006


Nicole Erquiaga
2/23/2006
Date